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JOSEPH M. SAUER
JONES DAY REAVIS & POGUE
NORTH POINT, 901 LAKESIDE AVENUE
CLEVELAND, OH 44114

EXAMINER
DARNO, PATRICK A

ART UNIT	PAPER NUMBER
2163	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/643,029	SMITH, CHRISTOPHER D.	
	Examiner	Art Unit	
	Patrick A. Darno	2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 March 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17 and 54* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17 and 54* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 August 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 18-53 have been cancelled. Claims 1-3, 6, 8-16, and 54 have been amended. Claims 1-17 and 54 are pending in this office action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-14, 16-17, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication Number 2003/0065738 issued to Victor Shiang Yang et al. (hereinafter "Yang") in further view of U.S. Patent Application Publication Number 2004/0087300 issued to John Ervin Lewis (hereinafter "Lewis").

Claim 1:

Yang discloses a system for triggering a provisioning event in a service provider using a provisioning request message generated by an external system, comprising:

a provisioning system *(Yang: Fig. 1b, 130 and 137)* operable to receive the provisioning request message *(Yang: paragraph [0049]; While the example discussed here has the user issue the provisioning request, it is noted that another external entity may also issue this request (paragraph [0047]).)* from the external system *(Yang: paragraph [0047], lines 1-8; Note the user may issue the provisioning request message or the call center (service provider) may issue the provisioning request message or some other entity (external system) may issue the provisioning request message.)* and transmit information in the provisioning request message to the service provider to trigger the provisioning event *(Yang: paragraph [0049], line 1 - paragraph*

[0051], line 8), the provisioning system being a separate entity from the external system and the service provider (*Yang: Fig. 1b, 130 and 137; The provisioning system (Fig. 1b, 130) is in fact a separate entity than the external system (not shown in diagram, but mentioned in paragraph [0047], lines 1-8) and the service provider (Fig. 1b, 150).*);

wherein the information includes one or more attributes defined by the external system *(Yang: paragraph [0047], lines 1-8; Again, note that the provisioning request message can be issued by an external system (other entity). Therefore, if an external system issues the request, the external system must define all the attributes of the message in Fig. 4a.)*;

the provisioning system in communication with the external system and the service provider *(Yang: paragraph [0049], line 1 - paragraph [0051], line 8; The provisioning system communicates with the external system when the external system makes the request. And the provisioning system communicates with the service provider through the application manager on the users mobile device.)*, wherein the service provider is operable to communicate with the entity to cause the provisioning event to occur in response to receiving the provisioning request message from the provisioning system *(Yang: paragraph [0051], lines 1-8 and paragraph [0066])*;

the service provider operable to provide mobile communication service to the entity *(Yang: paragraph [0021]; The system allows for the user to 'obtain information and services over a wireless communications network'. Surely this involves the service provider providing the entity with some form of mobile communication service.)*.

Yang does not explicitly disclose wherein the provisioning request message includes information identifying an entity to which the provisioning event pertains.

However, Lewis discloses wherein the provisioning request message includes information identifying an entity to which the provisioning event pertains *(Lewis: paragraph [0121], lines 5-9 and paragraph [0127], lines 1-5; The first reference shows that the routing information contains a destination device type. The second reference shows the routing information is part of the overall provisioning message to be sent. It is clear that the message sent is a provisioning request because it is used to verify the status of a subscription from a subscriber (service provider). This is one example from the applicant's specification of a provisioning event in paragraph [0009]. Note particularly where applicant states provisioning events include "status information associated with a service." Since the message sent in the Lewis reference is a request to perform a provisioning event, the request must be a provisioning request (see paragraph [0012], lines 3-6 of applicant's specification). And the provisioning request message used by Lewis further includes "information identifying an entity to which the provisioning event pertains". This information in the Lewis reference is the 'Destination Device Type'. This routing information that is part of the provisioning request message makes is the provisioning entity section.).*

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Yang with the teachings of Lewis noted above for the purpose of including a destination device type ("information identifying an entity") inside a provisioning request *(Lewis: paragraph [0121], lines 5-9 and paragraph [0127], lines 1-5; First note that the routing information contains a device type. Then note that the routing information is part of the overall provisioning message to be sent.)*. The skilled artisan would have been motivated to improve the invention of Yang per the above such that the destination device type would aid in the delivery process of the provisioning request *(Lewis: paragraph [0150], lines 5-8; The ARC receive the provisioning request from the subscriber (provisioning system) and then direct the provisioning request to the appropriate device*

type. So one of ordinary skill in the art can clearly see that the device type can play an important role in the delivery of a provisioning request.).

Claim 2:

The combination of Yang and Lewis discloses all the elements of claim 1, as noted above, and Lewis further discloses wherein the one or more attributes include a name attribute that identifies the entity *(Lewis: paragraph [0121], lines 5-9; The destination device type is the name attribute that identifies the entity. See rejection of claim 1 for further explanation of this reference.).*

Claim 3:

The combination of Yang and Lewis discloses all the elements of claim 1, as noted above, and Lewis further discloses wherein the one or more attributes include a type attribute that identifies an entity type of the entity *(Lewis: paragraph [0121], lines 5-9).*

Claim 4:

The combination of Yang and Lewis discloses all the elements of claim 3, as noted above. Yang does not explicitly disclose wherein the type attribute identifies a model number of the entity. However, Lewis further discloses wherein the type attribute identifies a model number of the entity *(Lewis: paragraph [0361], lines 1-4; The mobile identification number is the model number.).*

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the previously mentioned combination with the further teachings of Lewis noted above. The skilled artisan would have been motivated to further improve the previously mentioned combination per the above such that user and device information stored in a database can be used for routing messages, validation of services, and for enabling other data

services *(Lewis: paragraph [0319]; This shows that the information stored in the MIND database can also be used in the provisioning requests disclosed by Lewis. Note that it specifically states that data stored in the MIND database (subscriber information) can be used for "routing messages" (or provisioning requests). And as cited in the rejection of claim 1, the routing information is part of the provisioning request.).*

Claim 5:

The combination of Yang and Lewis discloses all the elements of claim 1, as noted above, and Yang further discloses wherein the service provider is a mobile data service provider *(Yang: paragraph [0041], lines 2-5 and 12-15).*

Claim 6:

The combination of Yang and Lewis discloses all the elements of claim 1, as noted above, and Lewis further discloses wherein the provisioning request message further includes provisioning data that identifies a particular entity to which the provisioning event pertains *(Lewis: paragraph [0121], lines 5-9 and paragraph [0127], lines 1-5; See rejection of claim 1 for a detailed explanation of this reference.).*

Claim 7:

The combination of Yang and Lewis discloses all the elements of claim 6, as noted above, and Yang further discloses wherein the particular entity is a mobile communication device *(Yang: paragraph [0006], lines 1-3 and paragraph [0042], lines 4-8).*

Claim 8:

The combination of Yang and Lewis discloses all the elements of claim 6, as noted above, and Lewis further discloses wherein the provisioning data includes one or more attributes defined by the external system *(Lewis: paragraph [0319] and paragraphs [0035] and [0038]; The first*

reference shows that the information stored in the MIND database can also be used in the provisioning requests disclosed by Lewis. Note that it specifically states that data stored in the MIND database (subscriber information) can be used for "routing messages" (or provisioning requests). And as cited in the rejection of claim 1, the routing information is part of the provisioning request. The second reference gives attributes defined by the external system and stored in the MIND database. These attributes from the MIND database can be included in the routing message and when the routing information is combined with the provisioning request message, as described above, the section of the message containing the attributes of the destination device is the provisioning data section.).

Claim 9:

The combination of Yang and Lewis discloses all the elements of claim 8, as noted above, and Lewis further discloses wherein the one or more attributes include a name attribute that identifies a type of information included within the provisioning data *(Lewis: paragraph [0385] and [0388]; Note that all the name attributes listed by the applicant in paragraph [0024] are also listed in the cited paragraphs from Lewis. And again, the attributes listed in the cited paragraphs from Lewis can be included in the routing information (Lewis: paragraph [0319]), and the routing information is then added to the provisioning request message. Further note that the reason Lewis incorporates these attributes so that a message can specify requests to provision entities (destination devices) on a plurality of diverse systems using different schemas (Applicant's specification paragraph [0024] and Lewis: paragraph [0093], lines 5-10).).*

Claim 10:

The combination of Yang and Lewis discloses all the elements of claim 9, as noted above, and Lewis further discloses wherein the type of information included within the provisioning data includes a personal identification number (PIN) for the entity *(Lewis: paragraph [0388], lines 15-17).*

Claim 11:

The combination of Yang and Lewis discloses all the elements of claim 9, as noted above, and Lewis further discloses wherein the type of information included within the provisioning data includes a product identifier for the entity *(Lewis: paragraph [0361] and paragraph [0319], lines 7-8; The device identifier is the product identifier.)*.

Claim 12:

The combination of Yang and Lewis discloses all the elements of claim 9, as noted above, and Lewis further discloses wherein the type of information included within the provisioning data includes a billing identifier for the entity *(Lewis: paragraph [0350], line 10 and paragraph [0319])*.

Claim 13:

The combination of Yang and Lewis discloses all the elements of claim 9, as noted above, and Lewis further discloses wherein the type of information included within the provisioning data includes an international mobile subscriber identity identifier (IMSI) for the entity *(Lewis: paragraph [0388], lines 1-6 and paragraph [0319])*.

Claim 14:

The combination of Yang and Lewis discloses all the elements of claim 9, as noted above, and Lewis further discloses wherein the type of information included within the provisioning data includes a mobile subscriber integrated services digital network number (MSISDN) for the entity *(Lewis: paragraph [0388], lines 1-6 and paragraph [0319])*.

Claim 16:

The combination of Yang and Lewis discloses all the elements of claim 1, as noted above, and Lewis further discloses wherein the provisioning request message includes additional

information identifying one or more additional entities to which the provisioning event pertains, and wherein the additional information includes one or more attributes defined by the external system *(Lewis: paragraphs [0172] and [0173]; These references disclose sending provisioning requests to multiple or additional users. The multiple users are taken from a distribution list and all the users receive the same messages. Further additional users can be added to any list. Further for each additional user device type, destination address, and all other attributes are included in the message (this is equivalent to the provisioning entity and provisioning data item sections).).*

It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the previously mentioned combination with the further teachings of Lewis noted above. The skilled artisan would have been motivated to further improve the previously mentioned combination per the above such that a single message would contain routing information for multiple devices *(Lewis: paragraph [0121], lines 1-5).*

Claim 17:

The combination of Yang and Lewis discloses all the elements of claim 16, as noted above, and Lewis further discloses wherein a data structure relationship between the provisioning entity section and the one or more additional provisioning entity sections is defined by the external system *(Lewis: paragraphs [0172]-[0173]; The distribution list on the external system creates the data structure relationship between the additional entities.).*

Claim 54:

Claim 54 is rejected under the same reasons set forth in the rejection of claims 1.

3. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yang in further view of Lewis and further in view of U.S. Patent Application Publication Number 2004/0058652 issued to Christopher M. McGregor et al. (hereinafter "McGregor").

Claim 15:

The combination of Yang and Lewis discloses all the elements of claim 9, as noted above, but does not explicitly disclose wherein the type of information included within the provisioning data includes an integrated circuit card identifier (ICCID) for the entity. However, McGregor discloses wherein the provisioning data includes an integrated circuit card identifier (ICCID) for the entity *(McGregor: paragraph [0201])*.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previously mentioned combination with the teachings of McGregor noted above. The skilled artisan would have been motivated to improve the teachings of the previously mentioned combination per the above such that the ICCID could be used to identify a particular mobile device *(McGregor: paragraph [0201], at least lines 3-7)*.

Response to Arguments

Applicant Argues:

Among other distinctions, the cited references do not include a provisioning system that receives a provisioning request message from an external system and transmits information in the provisioning request message to a service provider, as recited in claims 1 and 54.

The office action concludes that Figs. 1a and 1b of the Yang reference disclose the claimed provisioning system. In the telephone interview, Examiner Darno explained that it is his conclusion that the entire system disclosed in Figs. 1a and 1b is the provisioning system. The office action then concludes that the call center, which is one component of the system shown in Figs. 1a and 1b, corresponds to the claimed service provider. This conclusion cannot be correct.

Claims 1 and 54 specifically require that the provisioning system receives a message from an external system and then transmits information from this message to the service provider. The claimed service provider and provisioning system CANNOT therefore be the same thing as concluded by the office action.

Examiner Responds:

After further review of the instant application, the Examiner agrees with the Applicant that the service provider and the provisioning system cannot be the same thing. However, with that said, the Examiner remains convinced that the combination of Yang and Lewis discloses all the elements of at least Applicant's claim 1.

The Examiner was incorrect in his interpretation of the Yang reference given in the interview with the Applicant's representative. And it is noted that there were some inconsistencies in the Examiner's prior office action. The Applicant's remarks brought these inconsistencies to light, and forced the Examiner to reconsider the references. The Examiner thanks the Applicant for his help in bringing these inconsistencies to the Examiner's attention such that the record may be clarified.

With respect to claim 1, after further consideration, it is clear that the Yang reference discloses a provisioning system (Yang: Fig. 1b, 130), service provider (Yang: Fig. 1b, 150), and external system (Yang: paragraph [0047]; "other entity" – This has been adequately explained above.). Note that each entity is separate and unique from the other.

With that mapping of claim elements in mind, it is indeed clear that the cited references include a provisioning system that receives a provisioning request from an external system (Yang: paragraph [0047] and paragraph [0049]). While the example discussed in the specification has provisioning system (Yang: Fig. 1b, 130) receive a provisioning request from a user, it is clear from paragraph [0047] of the Yang reference that some other entity besides the user or call center (provisioning system) can issue this provisioning request. The Examiner's

interpretation of the Yang reference yields the conclusion that this 'other entity' is the external system claimed by the Applicant.

Finally, as detailed at paragraph [0049], line 1 – paragraph [0051], line 8 of the Yang reference, the reference discloses the provisioning system (Yang: Fig. 1b, 130) transmitting a provisioning request message, which is based on and includes information from the original provisioning request, through the Application Manager (Yang: Fig. 1b, 112) on the users mobile device (Yang: Fig. 1b, 110) to the service provider (Yang: Fig. 1b, 150).

Based upon this refined interpretation of the cited prior art, the Examiner believes it is clear that the cited prior art includes a provisioning system that receives a provisioning request message from an external system and transmits information in the provisioning request message to a service provider, as recited in Applicant's claims 1 and 54.

Therefore, since it is clear that the cited prior art appears to disclose or suggest each and every element of the Applicant's claimed invention, the rejections given under 35 U.S.C. 103(a) are upheld.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick A. Darno whose telephone number is (571) 272-0788. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALFORD KINDRED
PRIMARY EXAMINER

Patrick A. Darno
Examiner
Art Unit 2163

PAD